

REMARKS

The Office action mailed on 19 November 2003 (Paper No. 4) has been carefully considered.

The specification is being amended to correct minor errors and improve form. Claims 2, 3, 13 and 14 are being canceled without prejudice or disclaimer, claims 1 and 11 are being amended, and new claims 22 thru 35 are being added. Thus, claims 1, 4 thru 12 and 15 thru 35 are pending in the application.

In paragraph 2 of the Office action, the Examiner rejected claims 1, 4 thru 12 and 15 thru 21 under 35 U.S.C. §102 for alleged anticipation by Kuo *et al.*, U.S. Patent No. 6,226,040. In paragraph 4 of the Office action, the Examiner rejected claims 2, 3, 13 and 14 under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040. For the reasons stated below, it is submitted that the invention recited in the claims, as now amended, is distinguishable from the prior art cited by the Examiner so as to preclude rejection under 35 U.S.C. §102 or §103.

Independent claim 1 is being amended to include the recitations from dependent claims 2 and 3, which are being canceled. Similarly, independent claim 11 is being amended to include the recitations from dependent claims 13 and 14, which are being canceled. It is submitted that these amendments to independent claims 1 and 11 should

result in allowance of independent claims 1 and 11 and their associated dependent claims.

In rejecting dependent claims 2, 3, 13 and 14 under 35 U.S.C. §103 for alleged unpatentability over Kuo *et al.* '040, the Examiner admitted (in paragraph 4 of the Office action) that Kuo *et al.* '040 did not disclose a controller which adds a highlight signal to video signals to thereby increase the level of the composed video signals of the highlight portion, and did not disclose a controller which tracks the highlight signal from the video signals to thereby decrease the level of the composed video signals of the highlight portion. However, the Examiner took “Official Notice” that “it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the old and well known superimposing the highlight signal on the video signal ... since it merely amounts of [sic] selecting an alternative equivalent device for adding highlight signal and video signal” (quoting from the paragraph bridging pages 4 and 5 of the Office action). The Examiner further took “Official Notice” and concluded that “it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the old and well known desuperimposing the highlight signal on the video signal ... since it merely amounts of [sic] selecting an alternative equivalent device for removing highlight signal from video signal” (quoting from the first complete paragraph on page 5 of the Office action).

However, in taking the latter “Office Notice”, the Examiner did not place on the

record of this application any evidence of the assertions that adding and/or subtracting a highlight signal from the video signals to thereby increase and/or decrease the level of the composed video signals of the highlight portion was "old and well known" in the art. It should be noted that, under the rules and the law governing rejections under 35 U.S.C. §103, it is incumbent upon the Examiner to support such assertions by placing on the record evidence, in the form of prior patents or publications, of the fact that such features and functions are "old and well known" in the art.

Furthermore, there is nothing within the "four corners" of the disclosure of Kuo *et al.* '040 which would suggest to or instruct a person of ordinary skill in the art as to the necessity or desirability of modifying the disclosure of Kuo *et al.* '040 in the manner suggested by the Examiner. That is, Kuo *et al.* '040 does not contain any suggestion or instruction which would lead a person of ordinary skill in the art to modify the disclosure of Kuo *et al.* '040 so as to provide the controller with the capability of adding or subtracting a highlight signal from video signals in order to increase or decrease the level of the composite video signals of the highlight portion.

For the above reasons, it is respectfully submitted that independent claims 1 and 11, and their associated dependent claims, recite the invention in a manner distinguishable from the prior art so as to preclude rejection under 35 U.S.C. §103.

New independent claim 22 and associated dependent claims 23 thru 35 are being added to provide complete protection of the invention by reciting various additional features of the displaying apparatus of the present invention. It should be noted that the elements and functions recited in independent claim 22 and associated dependent claims 23 thru 35 are fully disclosed in and supported by the disclosure of the present application, as originally filed.

It should be further noted that neither Kuo *et al.* '040 or any other reference cited in this application discloses or suggests a displaying apparatus comprising signal generating means, displaying means, selection means, storage means and control means with the functions recited in independent claim 22, wherein the control means comprises a highlight signal generating part and a signal composing part with the respective functions recited in the claim. It should also be noted that dependent claims 23 thru 35 recite the displaying apparatus of claim 22 in further detail so as to further define the invention over the prior art cited by the Examiner.

Finally, Figure 3 is being corrected to add reference numeral 17 which is mentioned in paragraph [0040] of the specification, and thereby rendering the figure consistent with the specification, as originally filed. Substitute formal Figure 3 which incorporates this correction is attached. Entry of formal Figure 3, in writing in the next Office action, is respectfully requested.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

A fee of \$180.00 is incurred by the addition of ten (10) total claims in excess of total 21. Additionally, a fee of \$110.00 is incurred by the filing of a Petition for a three-months extension of time attached hereto. Applicant's check drawn to the order of Commissioner accompanies this Amendment. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

  
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FIG. 3

